

Attorney Docket No.: J6673(C)
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BRIEF FOR APPELLANT

Sir:

This is a Brief on Appeal in response to the Notification of Non-Compliant Appeal Brief mailed August 2, 2006. Appellants have made a bona fide attempt to comply with 37 CFR §41.37(c) and appreciate the telephone assistance of Ms. Bridget C. Monroe, the Patent Appeals Specialist assigned to this appeal. The Commissioner is hereby authorized to charge any additional fees, which may be required to our deposit account No. 12-1155, including all required fees under: 37 C.F.R. §1.16; 37 C.F.R. §1.17; 37 C.F.R. §1.18.

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I. REAL PARTY IN INTEREST

The Real Party in Interest in this Appeal is Unilever Home & Personal Care USA, Division of Conopco, Inc. and a corporation of the State of New York.

II. RELATED APPEALS AND INTERFERENCES

Neither the Appellants, their legal representatives nor the Assignee are aware of any other Appeals or Interferences relating to the present Appeal.

III. STATUS OF CLAIMS

This Appeal is taken from the Final Rejection of claims 1-2, 5-6, and 9-10, the pending claims in the application. A copy of the appealed claims is attached to this Brief as an Appendix.

IV. STATUS OF AMENDMENTS

A Reply after Final was made on 10 May 2006, and no Amendments after the Final Rejection were present therein. The Amendment made on 2 November 2005 was entered by the Examiner.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The inventions set forth in the claims on appeal are directed to stable skin care products containing a first composition comprising about 0.001% to about 10% of a retinoid, and a second composition comprising about 0.0001% to about 50% of at least one retinoid booster and from about 0.001% to about 10% of at least one phytoestrogen, where a first compartment is provided to store the first composition and a second compartment is provided for storing the second composition further where the first and second compartments are joined together.

By the presently claimed invention, therefore, superior products for skin have been prepared. As may be readily gleaned from, for example, the experiments described in the specification, the stable skin care product of this invention has a dual component system that isolates retinoids and phytoestrogens to result in the boosting/enhancing of active component benefits while at the same time preventing active component degradation.

In the Specification, the portion from pages 1-2 and page 3, lines 1-3 is background. The phraseology used in claims 1 and 5, the independent claims, may be found on, for example, page 3, lines 10-20; page 25, lines 5-17; page 32, lines 16 to page 33, line 4,

and pages 48-50. Support for claims 2, 6, 9 and 10, the dependent claims being considered on the merits, may be found, among other places, on pages 3-38 of the specification as originally filed. Beginning at page 39, working examples and experiments illustrate the unexpected and superior results obtained when designing and utilizing the superior and desirable stable skin care product of this invention.

VI. GROUNDS OF THE REJECTION TO BE REVIEWED ON APPEAL

The issues raised in this appeal are primarily ones of fact and of the type normally encountered in connection with rejections made under 35 USC § 103. In particular, the issues are as follows:

I. Would one of ordinary skill in the art, upon reading Granger et al. (U.S. Patent No. 5,723,139, hereinafter, '139) Pillai et al. (U.S. Patent No. 6,548,072, hereinafter, '072) in view of Liu et al. (U.S. Patent No. 5,976,555, hereinafter, '555) and Soares et al. (U.S. Patent No. 5,941,116, hereinafter, '116) find that claims 1, 2, 5-6 and 9 are obvious under 35 USC §103; and

II. Would one of ordinary skill in the art, upon reading Granger et al. '139, Pillai et al. '072, Maybeck (FR 2,777,179, hereinafter, '179) in view of Liu et al., '555 and Soares et al. '116 find that claims 1, 2, 5-6 and 10 are obvious under 35 USC §103?

VII. APPELLANT'S ARGUMENTS

Appellants wish to point out that they have not been able to make contact with the Examiner to see if the present application was being passed to issue or if an Advisory Action was in order. Appellants response under 37 CFR §1.116 was filed with a Notice of Appeal on 10 May 2006. No official response to the 116 reply was ever received from the USPTO.

I. Rejection Under 35 USC §103

The Examiner did finally reject claims 1, 2, 5-6, and 9 under 35 USC §103 as being unpatentable over Granger et al., U.S. Patent No. 5,723,139 (hereinafter, '139) and Pillai et al., U.S. Patent No. 6,548,072 (hereinafter, '072) in view of Liu et al., U.S. Patent No. 5,976,555 (hereinafter, '555) and Soares et al., U.S. Patent No. 5,941,116 (hereinafter, '166). In the rejection, the Examiner mentions, in summary, that the rejection is maintained for what is apparently the reasons already made of record. Furthermore, the Examiner disputes Appellants' previous arguments and suggests that the '139 reference discloses a skin conditioning composition comprising retinal or retinyl ester in an amount from about 0.001% to about 10% in combination with a retinoid booster, polycyclic triterpene carboxylic acid and glycyrrhetic acid in an amount of from about 0.0001% to about 50%. The Examiner continues by mentioning that the '072 reference teaches skin

care compositions containing 5% w/w of chick pea extract which contains phytoestrogens such as genistein, formononetin, daidzein, biochanin A and others and 0.01% w/w of linoleic acid for improving the appearance of wrinkled, dry, flakey or aged skin. The Examiner continues by mentioning that the '555 reference teaches that retinoids such as retinal and retinyl ester in skin care compositions are unstable due to oxidation or isomerization to non-efficacious chemical forms, and further teaches that several stable compositions for skin care can be supplied in two bottles separating retinoids from other ingredients. Finally, the Examiner continues by concluding that the '116 reference shows dual container systems for multi-composition use. In view of this, the Examiner maintains that one of ordinary skill in the art would have found it obvious at the time the invention was made to employ two compartments, the first one for storing retinoids and the second one for storing retinoid booster and a phytoestrogen to keep retinoids from reacting with its booster in order to preserve the stability of retinoids and avoid chemical degradation prior to use. Thus, the Examiner believes that the rejection made under 35 USC §103 is warranted.

Notwithstanding the Examiner's apparent position to the contrary, it is the Appellants' position that the presently claimed invention is patentably distinguishable from the above-described for at least the following reasons.

As already made of record, the present invention is directed to a stable skin care product containing a first composition comprising about 0.001% to about 10% of a retinoid; and a second composition comprising about 0.0001% to about 50% of at least one retinoid booster selected from the group consisting of arachidic acid, myristic acid, amsacrine, carbenoxolone, glycyrrhetic acid, phosphatidyl ethanolamine, sphingomyelin, phosphatidylcholine, and mixtures thereof, and from about 0.001% to about 10% of at

least one phytoestrogen selected from the group consisting of genistein, diadzein, glycitin, biochanin A, formononetin, equol, and mixtures thereof, a first compartment for storing the first composition and a second compartment for storing the second composition whereby the first and second compartments are joined together.

The invention of claim 1 is further defined by the dependent claims which claim, among other things, that two retinoid boosters may be used in an amount from about 0.0001% to about 50% in the second composition.

Independent claim 5 is directed to a stable skin care product containing a first composition and a second composition wherein the first composition comprises from about 0.001% to about 10% of a retinoid to provide a first benefit, and the second composition comprising from about 0.0001% to about 50% of at least one retinoid booster selected from the group consisting of vanillin, arachidic acid, linoleic acid, myristic acid, amsacrine, carbenoxolone, glycyrrhetic acid, phosphatidyl ethanolamine, sphingomyelin, phosphatidylcholine, and mixtures thereof; and about 0.001% to about 10% of at least one phytoestrogen selected from the group consisting of genistein, diadzein, glycitin, biochanin A, formononetin, equol, and mixtures thereof, the booster and phytoestrogen boosting the first benefit; a first compartment for storing the first composition; and a second compartment for storing the second composition, the first and second compartments being joined together.

The invention of claim 5 is further defined by the dependent claims which claim, among other things, that the second composition can have at least two retinoid boosters in an amount of from about 0.0001% to about 50%, and that the retinoid booster may be

selected from the group consisting of glycyrrhetic acid, phosphatidylcholine, and mixtures thereof.

In contrast, and as already made of record, the '139 reference is merely directed to a skin care composition having a polycyclic triterpene carboxylic acid and a retinoid. The '139 reference does not teach or suggest, even remotely, the use of the claimed phytoestrogens. Moreover, the '139 reference does not teach or suggest the storage of a first composition comprising retinoid and a second composition comprising retinoid booster, and phytoestrogens in a separate compartment that is joined with a compartment holding the first composition. In an attempt to cure the vast deficiencies of the primary reference, the Examiner relies on the '072 reference. The '072 reference, however, is not prior art under 35 USC §103 and it is improper for the Examiner to rely on the '072 reference. This is true because the subject matter of the '072 patent and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. Appellants respectfully direct the Examiner's attention to the fact that Conopco, Inc. was the owner of the subject matter of the '072 patent and the claimed invention at the time the invention was made. Thus, again, the '072 reference is not suitable to be relied on in the present 35 USC §103 rejection. Turning to the '555 reference, the same discloses a skin care composition having an oil-in-water emulsion base containing retinoids and possessing good physical and chemical stability. It has been reported in the '555 reference that the use of retinoids in topical compositions are unstable and can either oxidize or isomerize to non-efficacious chemical forms resulting in an amount of retinoid which is so low it is unacceptable to provide a benefit. The attempts made to stabilize the retinoid in the '555 reference require a complex oil-in-water emulsion system for stabilization wherein the stabilizing system is one which requires, for example, oil-soluble

antioxidants, chelating agents, or chelating agents and oil soluble antioxidants, or chelating agents and an antioxidant present in each of the oil and water phases of the emulsion. There is no teaching whatsoever in the '555 reference that even remotely suggests the combination of specific retinoids with specific boosters and phytoestrogens as claimed in the present invention. The two component system as claimed in this invention, as well as the two preferred boosters as claimed in this invention are not even remotely suggested by the '555 reference which, again, employs a complicated oil-in-water emulsion system to stabilize certain retinoids. Finally, the '116 reference teaches away from the presently claimed invention. Again, and as already made of record, the '116 reference merely describes a method for a skin treatment regime wherein a first and second composition are stored in separate containers and only connected to each other to remind the consumer to use the compositions in tandem and to facilitate in one sale all necessary elements of a suggested regime. Thus, the '116 reference clearly teaches away from the present invention and cures none of the vast deficiencies of the primary reference since it discloses two separate containers for separating two different skin actives for two different benefits. Moreover, the reference fails to even remotely teach, suggest or disclose the need to separate phytoestrogens from retinoids. The present invention, again, is directed to two separate compositions with one intended to boost the benefit of the other. According to the present invention, the two compositions are intended to be applied simultaneously or consecutively, but are kept separately for stability reasons. The presently claimed invention clearly conveys that the specified retinoids and the phytoestrogens, although separated into two compartments, are there for the same benefit. The first composition provides a benefit to the skin while the second composition works to boost or enhance the effect of the first composition. Again, the '116 reference teaches away from the present invention and fails to provide

any suggestion or motivation to store compositions in the matter set forth in the present invention as claimed.

The storage of the compositions in separate containers as set forth in the presently claimed invention is novel and unobvious. None of the references relied on by the Examiner, even remotely, teach all the important and critical limitations set forth in the presently claimed invention. Moreover, and as already made of record, the '072 reference is not prior art. Since the Examiner has not established a *prima facie* case of obviousness as required under 35 USC §103, Appellants request that the obviousness rejection made to claims 1, 2, 5-6 and 9 be withdrawn and rendered moot.

II. Rejection Under 35 USC §103

The Examiner has finally rejected claims 1, 2, 5, 6 and 10 under 35 USC §103 as being unpatentable over Granger et al., U.S. Patent No. 5,723,139 (hereinafter, '139) and Pillai et al., U.S. Patent No. 6,548,072 (hereinafter, '072) and Maybeck, FR 2 777 179 (hereinafter, '179) in view of Liu et al., U.S. Patent No. 5,976,555 (hereinafter, '555) and Soares et al., U.S. Patent No. 5,914,116 (hereinafter, '116). In the final Office Action, the Examiner maintains the rejection previously made of record. In addition to what has been mentioned above, the Examiner relies on the '179 reference for apparently showing skin care compositions with retinoid, retinoid boosters, and glycyrrhetic acid. Particularly, the Examiner concludes, that such a composition can be used for treating skin conditions, such as acne, dry skin and the like. In light of this, the Examiner believes that the obviousness rejection should be maintained and is warranted.

Notwithstanding the Examiner's apparent position to the contrary, it is the Appellants' position that the presently claimed invention is patentably distinguishable from the above-described for at least the following reasons.

As already made of record above, the '139 reference is directed to skin care compositions with polycyclic triterpene carboxylic acid and a retinoid. The '139 reference does not, even remotely, teach or suggest the claimed phytoestrogens. Moreover, the '139 reference does not teach or suggest the storage of a first composition comprising retinoid and a second composition comprising retinoid booster and phytoestrogens in a separate compartment whereby the two compartments are joined together.

As already made of record, the '072 reference is not prior art under 35 USC §103(c). The '179 reference appears to be directed to a cosmetic vehicle containing siloxane. Simply because the '179 reference appears to disclose phosphatidylcholine and glycyrrhetic acid somewhere in its disclosure clearly does not make it obvious for one of ordinary skill in the art to combine these materials with retinoids and with retinoid boosters in a dual compartment package and to come up with the present invention. The Examiner is not allowed to pick and choose elements from numerous references without there being motivation to combine the same. Furthermore, and as already made of record, the '555 reference is merely directed to the use of a complex oil-in-water emulsion comprising a specifically defined stabilizing system to stabilize certain retinoids. It has nothing to do with a dual compartment system as claimed in the present invention. Finally, and again, the '116 reference is directed to a treatment regime for skin that employs two different compositions that are to be used for two different benefits. The two different compositions have two different skin actives and they are stored in two separate containers. Again, the present invention is directed to two separate compositions with one intended to boost the other.

Based on the above, it is clear that all the important and critical limitations set forth in the presently claimed invention are not found in the combination of references relied on by the Examiner. In view of this, Appellants respectfully submit that a *prima facie* case of obviousness has not been established and the rejection made under 35 USC §103 should be withdrawn and rendered moot.

VIII. CONCLUSION

Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the Examiner's final rejection of claims 1-2, 5-6 and 9-10, and pass such claims to issue. Again, it is respectfully submitted that no Advisory Action has been provided to Appellants.

IX. CLAIMS APPENDIX

1. A stable skin care product containing:

a first composition comprising about 0.001% to about 10% of a retinoid;

a second composition comprising about 0.0001% to about 50% of at least one retinoid booster selected from the group consisting of arachidic acid, myristic acid, amsacrine, carbenoxolone, glycyrrhetic acid, phosphatidyl ethanolamine, sphingomyelin, phosphatidylcholine, and mixtures thereof; and from about 0.001% to about 10% of at least one phytoestrogen selected from the group consisting of genistein, diadzein, glycitin, biochanin A, formononetin, equol, and mixtures thereof;

a first compartment for storing the first composition; and

a second compartment for storing the second composition the first and second compartments being joined together.

2. The stable skin care product of claim 1 wherein the second composition has at least two retinoid boosters in an amount of about 0.0001% to about 50%.

3-4. (canceled)

5. A stable skin care product containing:

a first composition comprising about 0.001% to about 10% of a retinoid to provide a first benefit;

a second composition comprising about 0.0001% to about 50% of at least one retinoid booster selected from the group consisting of vanillin, arachidic acid, linoleic acid, myristic acid, amsacrine, carbenoxolone, glycyrrhetic acid, phosphatidyl ethanolamine, sphingomyelin, phosphatidylcholine, and mixtures thereof; and about 0.001% to about 10% of at least one phytoestrogen selected from the group consisting of genistein, diadzein, glycitin, biochanin A, formononetin, equol, and mixtures thereof, the booster and phytoestrogen boosting the first benefit;

a first compartment for storing the first composition; and

a second compartment for storing the second composition the first and second compartments being joined together.

6. The stable skin care product of claim 5 wherein the second composition has at least two retinoid boosters in an amount of about 0.0001% to about 50%.

7-8. (canceled)

9. The stable skin care product of claim 5 wherein said retinoid booster is selected from the group consisting of Glycyrrhetic acid, phosphatidylcholine, and mixtures thereof.

10. The stable skin care product of claim 6, wherein said retinoid boosters are glycyrrretinic acid and phosphatidylcholine.

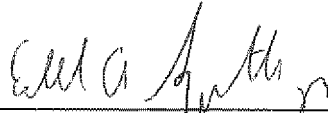
X. EVIDENCE APPENDIX

No evidence pursuant to §§ 1.130, 1.131 and/or 1.132 is/are submitted herewith.

XI. RELATED PROCEEDINGS APPENDIX

No decisions rendered by a Court or the Board have been made. Therefore, no such decisions are submitted herewith.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Edward A. Squillante, Jr.", written over a horizontal line.

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